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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/380,888	10/27/99	DUPUIS	C 05725.0432 <i>DT</i>

HM12/0403  
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EXAMINER
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WELLS, L

ART UNIT	PAPER NUMBER
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1619

*8*

DATE MAILED:

04/03/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.

09/380,888

Applicant(s)

DUPUIS, CHRISTINE

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### DETAILED ACTION

Claims 18-53 have been presented for examination and will be reviewed upon their merits.

#### *Specification*

The amendment filed April 10, 2000 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: -CO-A-CO-O-(CH<sub>2</sub>CH<sub>2</sub>)<sub>n</sub>-; -CO-A-CO-O-(CH<sub>2</sub>CH<sub>2</sub>)<sub>n</sub>-OH; sodium dimethyl isophthalate-5-sulphonate..

Applicant is required to cancel the new matter in the reply to this Office Action.

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-29, 32-36 and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-23 .S. Patent No. 6031043.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed toward analogous hair care compositions comprising terephthalic copolyester oligomers comprising dicarboxylate repeating units of formula (I) as hydrophilic gelling polymers. The claimed subject matter overlaps and the compositions of the application and the patent appear to be the same.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-34 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As previously described, the claimed hydrophilic gelling polymer of claim 23 is new matter that was neither recited nor described in the original specification. Furthermore, the claimed hydrophilic gelling polymer of claim 23 is not supported by the foreign priority document.

Claims 31, 38, 29, 46, 47 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 31, 38, 39, 46, 47, and 49 are rejected for the use of

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improper Markush groups. See MPEP 2173.05(h) for examples of proper conventional or alternative Markush-type language.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-29, 35, 36 and 39 rejected under 35 U.S.C. 102(e) as being anticipated by Dupuis et al. (6,031,043).

Dupuis et al. teaches topical compositions comprising a hydrophilic gelling agent of the polyester sulphone type. The hydrophilic gelling agent is disclosed as a water-dispersible terephthalic copolyester oligomer comprising repeating dicarboxylate units of formula (I), which meets claims 1-23. Percent weights and molecular weights are disclosed, which meet claims 36-29 and 32-36. Hair fixing materials are disclosed as additive, which meets claim 39.

***Claim Rejections - 35 USC § 103***

Claims 18-45 and 48-53 rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neill et al. (4,300,580) in view of Disselbeck et al. (5,804,025) in further view of Adams et al. (WO 95/00105).

O'Neill et al. teach hair grooming methods using linear polyesters. Linear polyesters disclosed are derived from at least one dicarboxylic acid, at least one diol, and a difunctional monomer containing a  $-\text{SO}_3\text{M}$  group attached to an aromatic nucleus. The polymer is made by mixing dimethyl isophthalate (1,3 phenylene group), dimethyl terephthalate (1,4 phenylene group), dimethyl 5-sodiumsulfoisophthalate(sulfo-1,3-phenylene group), and diethylene glycol together, which meets claims 28, 29, 30, and 31. The polyester is then mixed as a 5% solids solution with a mixture of solvents and modified with 5% Carboxwax 600 polyethylene glycol, which meets claim 35, 36, and 38. The composition is applied as a spray to the hair, which meets claims 40 and 41. Additives disclosed include dyes, pigments, stabilizers, and plasticizers, which meets claim 39. See Col. 1, line 40-Col. 6, line 16.

Disselbeck et al. teach a process for the melting of polyester-comprising shaped structures and the use of such polyesters. Isophthalic acid modified polyethylene terephthalate is disclosed as the modified polyester. Disclosed is a modified polyethylene terephthalate containing the structural repeat units of (III)  $-\text{O}-\text{OC}-\text{Ar}_3-\text{CO}-\text{O}-\text{R}_3-$  and (IV)  $\text{O}-\text{OC}-\text{Ar}_4-\text{CO}-\text{O}-\text{R}_4-$ , wherein  $\text{Ar}_3$  is preferably 1,4-phenylene and  $\text{Ar}_4$  is preferably 1,3 phenylene, wherein 40-95 mol % of the structural repeat units are formula III and 60-5 mol % of the structural repeat units are formula IV, which meets claims 24, 25, 26, 27. See Col. 1, line 45-Col. 4, line 38; Col. 5, line 23-Col. 6, line 62.

Adams et al. teach hair spray formulations having increased clarity. The composition disclosed comprises a sulfopolyester, a dicarboxylic acid selected from the aromatic dicarboxylic acids, diols, a difunctional sulfomonomer attached to an aromatic nucleus, and a liquid vehicle. Specific examples of dicarboxylic acids disclosed include terephthalic acid and isophthalic acid.

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Aerosol hair spray formulations comprising 3-40% by weight propellants are disclosed, which meets claims 45, 46, and 50. Propellants disclosed include dimethyl ether, and C1-C4 aliphatic hydrocarbons, which meets claims 43, 45, 49, and 49. See pg. 1, line 20-pg. 9, line 31.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the polyester of O'Neill et al. by substituting the mole percents of the 1,4-phenylene and 1,3 phenylene groups of Disselbeck et al. into the polyester, because of the expectation of achieving a specific intrinsic viscosity as disclosed by Disselbeck et al. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding the propellant of Adams et al. because the teaching of a hairspray by O'Neill et al. would have rendered it obvious to look to the prior art for how to make such a spray. Furthermore, the claimed processes are inherent to the claimed composition and the claimed device because the claimed composition is a hair fixative and the claimed device is an aerosol. All recited ingredients are well known in the hair fixative art. Although the claimed ranges of the ingredients are found in the prior art cited, no criticality of these ranges have been established by the applicants.

Claims 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neill et al., Disselbeck et al., and Adams et al. as applied to claim 18-45 and 48-53 above, and further in view of Dupuis (5,830,438).

The references are applied as discussed above. The references fail to teach one of the preferred embodiments of the propellant.

Dupuis teaches cosmetic hair care foam compositions. Aerosol containers are disclosed wherein the propellant is compressed air, carbon dioxide, nitrogen, dimethyl ether, hydrocarbons,

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and halogenated hydrocarbons, which meets claims 46, 47, 48, and 49. See Col. 4, lines 50-67; Col. 1, line 4-Col. 2, line 47.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by substituting the propellants of Dupuis for those of the combined references, because of the expectation of achieving an aerosol composition and because Dupuis teaches these propellants as interchangeable, Col. 4, lines 55-59.

Hence, the claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references. Therefore, the claims are properly rejected under 35 U.S.C. § 103.

#### ***Prior Art***

The prior art made of record and not specifically relied upon in any rejections cited above is either 1) considered cumulative to the prior art that was cited in a rejection or is 2) considered pertinent to the applicant's disclosure and shows the state of the art in its field but is not determined by the Examiner to read upon the invention currently being prosecuted in this application.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the




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organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
March 26, 2001



DIANA DUDASH  
SUPERVISORY PATENT EXAMINER  
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